



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,390	11/14/2001	Ronald F. Brosnihan	0830.063	4941

7590 01/11/2005

Jeff Rothenberg, Esq.
Heslin Rothenberg Farley & Mesiit P.C.
5 Columbia Circle
Albany, NY 12203

EXAMINER

LAWRENCE JR, FRANK M

ART UNIT	PAPER NUMBER
----------	--------------

1724

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,390

Applicant(s)

BROSNIHAN ET AL.

Examiner

Duane S. Smith

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-28-36-38 is/are allowed.
- 6) ☒ Claim(s) 1-13, 29-33 is/are rejected.
- 7) ☒ Claim(s) 34-35, 39-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1724

1. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "means for attaching" in instant claim 1 is not described in the original specification only that the support is attachable or is attached to a plurality of modules. This is new matter.

2. Claims 1-6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 "means for attaching" is indefinite in that the instant specification fails to describe a specific means for attaching. The means plus function phrase "means for attaching" gives rise to claim analysis under 35 USC 112 6th paragraph. Following the guidelines set forth in MPEP 2181 under *In re Donaldson Co.* 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (en banc); a claim limitation expressed in means plus function language shall be construed to cover the corresponding structure described in the specification and equivalents thereof. In the instant case no structure is described in the instant specification as to "the means for attaching". If applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

Claims 2-6 are rejected as being dependent upon a rejected base claim.

Art Unit: 1724

3. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by either Estvanko(US Patent No. 6,058,852).

Estvanko teaches a skid(12) said skid comprising a platform(14,16,18,20) and a support(26,28,30) attached to said platform and means for attaching(col. 3 lines 60-61, col. 3 lines 11-13). The phrase “is attachable to a plurality of modules” as in instant claims 2-3 and 32-33 has been interpreted as intended usage of the support. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Estvanko is capable of attaching modules to a support, having means for attaching.

5. Claims 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonzalez et al(Us Patent No. 4,698,756),

Art Unit: 1724

Gonzalez et al teach a module(Fig. 6A) connectable to a modular system for monitoring a hydrogen-cooled generator, said module comprising a processor(106) for generating data associated with performance of the hydrogen-cooled generator; and at least one of a display(108) for displaying said data and a communications link(104) for transferring said data to a remote location. With regards to claims 8-10 such links are shown but are not labeled in Fig. 6B. Note data is generated from temperature sensors (RTD) to monitor heat overload of the generator cooling means as in instant claims 11-13. Gonzalez additionally disclose the methods steps as in instant claims 29-31(col. 4 line 49-col. 5 line 55).

6. Claims 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by either Klaar(US Patent No.4,139,057) or Carson et al.(US Patent No. 3,916,671).

Klaar teaches a method for use in monitoring a hydrogen-cooled generator, the method comprising providing a modular system for at least one of drying(12) of hydrogen gas in the hydrogen-cooled generator(3), generating data(15), and transferring data to a remote location(col.3 lines 5-10)

Carson et al teach a method for use in monitoring a hydrogen-cooled generator, the method comprising providing a modular system for at least one of determining gas purity(ICD) of hydrogen gas in the hydrogen-cooled generator(11), generating data(A), and transferring data to a remote location(R).

7. Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 1724

8. Claims 34-35 and 39-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 14-28 and 36-38 are allowed over the prior art of record.
10. Applicant's arguments filed 10-22-04 have been fully considered but they are not persuasive. Applicant argues that Estanvko fails to disclose means for attaching as in instant claim 1. Examiner respectfully disagrees in that such a limitation is new matter, *supra* and Estvanko does indeed disclose such means for attaching(col.3 lines 60-61, col. 3 lines 11-13). Applicant further argues that Gonzalez et al does disclose monitoring performance of a hydrogen cooled generator. Examiner respectfully disagrees in that Gonzalez does indeed measure performance, i.e. temperature of the generator and overheating of such generator. Applicant argues such items as optimization factors, discrete conditions of the windings of a generator to generate performance data, etc. However such limitations are not found in instant claim7 and are therefore moot. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant further argues that Gonzalez et al does not disclose a processor nor display nor communications link. Examiner respectfully disagrees in that Gonzalez et al does disclose such limitations(processor(102,106) , display(108),

Art Unit: 1724

communications links(104, arrows linking between referenced elements)). All other arguments have been considered but are not deemed to be persuasive.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Travis and Salmanson et al disclose pallet skids with supports and attaching means. Kuhn discloses filters for gas coolant of generators. Klaar '138 discloses monitoring leakage in generator cooling systems.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duane S. Smith whose telephone number is 571-272-1166. The examiner can normally be reached on 8:30-6:00 M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1724

Duane S. Smith
Primary Examiner
Art Unit 1724

DSS
1-7-05

dss

1-7-05